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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,060	11/08/1999	James T Kealey	014/002C	6093
22869	7590	10/15/2003	EXAMINER	
GERON CORPORATION 230 CONSTITUTION DRIVE MENLO PARK, CA 94025			GIBBS, TERRA C	
			ART UNIT	PAPER NUMBER
			1635	127

DATE MAILED: 10/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,060

Applicant(s)

KEALEY ET AL.

Examiner

Terra C. Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 25,26,28 and 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The previous Office action, mailed 10/6/03, is vacated, and is superseded by the instant Supplemental Office action.

This Office Action is a response to the Amendment filed on June 19, 2003.

New claims 27-29 are acknowledged.

Claims 23 and 25-29 are pending in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23 and 27 recite the limitation, “nucleotides 137-196, 290-319, and nucleotides 350-380 of hTR”. Since nucleotides of hTR are numbered differently in the art, it is unclear how the skilled artisan will identify “nucleotides 137-196, 290-319, and nucleotides 350-380 of hTR” where no specific hTR (e.g. sequence identified) is identified. Insertion of “nucleotides 137-196, 290-319, and nucleotides 350-380 of hTR (SEQ ID NO:1)” would overcome the instant rejection.

Nucleotide and/or Amino Acid Sequence Disclosure

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. §1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. More specifically, the paper copy of the Sequence Listing contains 29 sequences, however the computer readable form of the Sequence Listing contains 15 sequences, therefore the paper copy of the Sequence Listing and the computer readable form of the Sequence Listing do not match. To be fully responsive to this Office Action, this application must fully comply with 37 C.F.R. §1.821-1.825.

Specification

The amendment filed June 19, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The paper copy of the Sequence Listing contains 29 sequences, however the computer readable form of the Sequence Listing contains 15 sequences. No support for SEQ ID NOs: 16-29 of the paper copy of the Sequence Listing could be found in the originally filed Specification or claims. Further, upon examination of the parent application, 08/770,564, no support for SEQ ID NOs: 16-29 could be found, as the computer

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readable form of the Sequence Listing of the parent application only contains SEQ ID NOs: 1-

15. Therefore, SEQ ID NOs: 16-29 are considered to be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Conclusion

Claims 25, 26, 28 and 29 are objected to for depending on a rejected claim.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is (703) 306-3221. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

tcg

October 8, 2003


KAREN A. LACOURCIERE, PH.D
PRIMARY EXAMINER